



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,432	09/19/2003	Charles E. Hart	00-12D1	5728
10117 7590 05/06/2008 ZYMOGENETICS, INC. INTELLECTUAL PROPERTY DEPARTMENT 1201 EASTLAKE AVENUE EAST SEATTLE, WA 98102-3702			EXAMINER JIANG, DONG	
			ART UNIT 1646	PAPER NUMBER
			MAIL DATE 05/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/664,432	Applicant(s) HART ET AL.	
	Examiner DONG JIANG	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2-9, 11 and 22-25.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☒ Other: No amendment of claims accompanied the respons.

/Dong Jiang/
Primary Examiner, Art Unit 1646

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 2-5, 7-9, 11, 22, 23 and 25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara et al., US6,455,283 B1, for the reasons of record set forth in the previous Office Actions mailed on 8/22/07 and 1/25/08.

Applicants argument filed on 25 March 2008 has been fully considered, but is not persuasive for the following reasons. Applicants main argument is that the Examiner attempts to establish certain facts - namely, the allegation that defining the structural-functional relationship of a newly discovered protein was "routine in the art at the time the present invention was filed" - without supporting documentary evidence; that Examiner's reasons essentially rely on an "obvious to try" rationale, which, under KSR International Co. v. Teleflex Inc. and the PTO's own Guidelines for Determining Obviousness under KSR, is improper absent a proper finding that there are "a finite number of identified, predictable potential solutions" to the problem at hand; that Applicants have presented objective evidence (namely, Li et al. and Fredriksson et al., as cited in the Jaspers Declaration) establishing that a fragment of PDGF-C as claimed is unexpectedly superior in bioactivity to other fragments having partial N-terminal deletions; and that Applicants request that the Examiner provide documentary evidence of the assertion that "determining the structural-functional relationship of a newly discovered protein was routine." This argument is not persuasive, and the examiner provides the following documentary evidence at applicants request, which provides not only "obvious to try", but also motivation to make the truncated form of the molecule as claimed, and expectation of success. For instance, Uutela et al. (US7,105,481) discloses a new member of the PDGF/VEGF family of growth factors, PDGF-D, which is closely related to the PDGF-C in the instant application, and stimulates connective tissue growth or wound healing (abstract). Additionally, Uutela teaches that an additional member of the PDGF/VEGF family, PDGF-C, has a two-domain structure, a N-terminal CUB domain, and a C-terminal PDGF/VEGF homology domain (column 6, lines 30-38), and PDGF-C requires proteolytic removal of the N-terminal CUB domain for receptor binding and activation of the receptor (column 6, lines 53-55). Further, Uutela teaches that PDGF-D also comprises a N-terminal CUB domain, and a C-terminal PDGF/VEGF homology domain, and teaches a truncated form of PDGF-D with N-terminal truncation, and comprising residues 254-370 of SEQ ID NO:8 (a portion of the PDGF/VEGF homology domain of PDGF-D), which extends toward the N-terminus up to residue 234 of SEQ ID NO:8 (column 8, lines 24-36), and that the truncated homodimer PDGF-DD retains the functional activity, exhibiting marked angiogenic activity in vivo (column 33, lines 46-47). Clearly, PDGF-D is closely related to PDGF-C. This example clearly demonstrates that determining the structural-functional relationship of a polypeptide, and making functional fragments thereof are both desirable and routine in the art.

Note, the newly cited reference is at applicants request, and it is merely used to rebut applicants arguments, and it is not for sustaining any new ground of rejection.

Claims 6 and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara et al., US6,455,283 B1, as applied to claims 2-5, 7-9, 11, 22, 23 and 25 above, and further in view of Bentz et al., EP 0 512 844 A1, for the reasons of record set forth in the previous Office Actions mailed on 8/22/07 and 1/25/08, and for the reasons above.